

REMARKS

Claims 1-3 and 5-21 are pending in the present application.

The rejection of Claims 1-9 and 21 under 35 U.S.C. §112, second paragraph, is obviated by amendment.

The Examiner has rejected the claims since she has noted that  $c + d$  cannot be equal to zero when Claim 1 defines at least one of  $c$  and  $d$  as being a positive integer. In the present amendment, Applicants have amended Claim 1 to replace the term definition " $0 \leq c+d \leq 0.1$ " with " $0 < c+d \leq 0.1$ ." Therefore, Claim 1 requires that either Si or B be present in the hard film for cutting tools.

In view of the present amendment, Applicants submit that the rejection of Claims 1-9 and 21 as being indefinite should be withdrawn. Acknowledgement to this effect is requested.

In paper number 12, paragraph 9, the Examiner notes that the rejections over the art of record have been maintained until the aforementioned indefiniteness rejection has been overcome. In view of the foregoing amendment and remarks, it is believed that the outstanding art rejections should now be withdrawn. Specifically, Applicants note that none of the art of record disclose or suggest the claimed hard film for cutting tools containing Ti, Al, Cr, and N and/or C, *which further contains Si and/or B*.

Therefore, Applicants request that the following grounds of rejection be withdrawn:

- (a) the rejection of Claims 1, 3-9, and 21 under 35 U.S.C. §102(b) over JP 10-251831, JP 07-237010, JP 09-300105, JP 09-295204, JP 07-188901, JP 09-

256138, JP 09-041127, Munz et al, EP 1 132 498, US 6,033,734, US 6,033,768,  
or US 6,296,928;

- (b) the rejection of Claims 1, 3-9, and 21 under 35 U.S.C. §102(e) over  
US 6,220,797 or US 6,492,011;
- (c) the rejection of Claims 1-9 under 35 U.S.C. §102(b) over JP 11-131216, JP 11-  
131215, JP 09-323205, JP 09-323204, JP 09-291353, or US 4,436,830;
- (d) the rejection of Claims 1-9 under 35 U.S.C. §102(a) over JP 2000-297365; and
- (e) the rejection of Claims 1-9 under 35 U.S.C. §102(e) over US 6,231,969,  
US 6,071,560, or JP 08-120445.

Acknowledgement that these rejections have been withdrawn is requested.

Finally, Applicants remind the Examiner that MPEP §821.04 states:

...if applicant elects claims directed to the product, and a product claim is  
subsequently found allowable, withdrawn process claims which depend from  
or otherwise include all the limitations of the allowable product claim *will be*  
rejoined. (*emphasis added*)

Applicants respectfully submit that should Claims 1-9 and 21 be found allowable,  
non-elected process Claims 11-15 should be rejoined and examined.

Moreover, Applicants note that Claim 10 provides a cutting tool that is coated with  
the hard film defined in Claim 1. Accordingly, should Claim 1 be found allowable Claim 10  
should also be rejoined and allowed.


An indication of such action is earnestly solicited.

Applicants submit that the present application is now in condition for allowance.

Early notification of such action is earnestly solicited.

Respectfully submitted,

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